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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,092	01/04/2005	Peter Josef Martin	2004-280	7017
27569	7590	10/19/2007		
PAUL AND PAUL 2000 MARKET STREET SUITE 2900 PHILADELPHIA, PA 19103			EXAMINER WEEKS, GLORIA R	
			ART UNIT 3721	PAPER NUMBER
			NOTIFICATION DATE 10/19/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/520,092

Applicant(s)

MARTIN, PETER JOSEF

Examiner

Gloria R. Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 19, 23-25, 29 and 30 are rejected 35 U.S.C. 102(b) as being anticipated by Johnson (USPN 3,956,872)

In reference to claims 19, 23-25, 29 and 30, Johnson discloses a packaging comprising: a blank having longitudinal and transverse fold lines; and a stamped marking on a wall panel (R) of the packaging blank, the marking comprising at least one center-symmetrical configuration having two straight lines having intersecting paths (dates including letters such as E, H, M, etc. and symbols – or /); wherein the marking correlates to dimensions and the geometry of the packaging as the markings are applied to a specific region of the packaging. Since the marking is recessed into the wall panel of the packaging, it is understood that a cross-section of the marking will have be U-shaped and have substantially a uniform thickness.

3. Claims 19, 23-25, 29-31, 33 and 34 are rejected 35 U.S.C. 102(e) as being anticipated by Guidotti et al. (US 2004/0259709).

Regarding claim 19, 23-25 and 29-30, Guidotti et al. discloses a packaging comprising: a blank having longitudinal and transverse fold lines (figure 2); and a stamped marking (18) on a wall panel of the packaging blank, the marking (18) comprising at least one center-symmetrical

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configuration having two straight lines (37d, 37e) with intersecting paths (figure 5), the marking having a U-shaped cross-section (paragraph 46); wherein the marking correlates to dimensions and the geometry of the packaging (paragraph 48).

With respect to claims 31, 33 and 34, Guidotti et al. discloses a package production process comprising: stamping a marking (18) and fold lines on packaging material (2; paragraphs 35 ad 37), wherein the marking comprises at least one center-symmetrical configuration having two straight lines (37d, 37e) with intersecting paths (figure 5), the marking having a U-shaped cross-section (paragraph 46); shaping, filling and sealing the packaging material (paragraph 33); and reading the marking (18) with an optical sensor (paragraph 16).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20-22 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guidotti et al. (US 2004/0259709) in view of Katayama et al. (USPN 6,079,188).

Regarding claims 20-22 and 26-28, Guidotti et al. discloses a stamped marking having an outer rectangular shape with a stamped Z design. Although Guidotti et al. does not disclose the stamped design of a rhombus or parallelogram, it would have been obvious to one having ordinary skill in the art at the time of the invention to stamp the marking of Guidotti et al. in various designs, specifically that of a parallelogram or rhombus, since column 6 lines 47-49 of

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Katayama et al. suggest that it is well known in the art of packaging material to apply markings of any desired configuration.

6. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guidotti et al. (US 2004/0259709).

In reference to claim 32, Guidotti discloses a packaging blank made from known packaging material. It was well known in the art at the time of the invention to form packaging from paper material.

### ***Response to Arguments***

7. Applicant's arguments filed August 7, 2007 have been fully considered but they are not persuasive.

8. During patent examination of the claims, the pending claims must be given their broadest reasonable interpretation consistent with the specification.<sup>1</sup> Moreover, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, *this is not the mode of claim interpretation to be applied during examination*. During examination, the claims must be interpreted as broadly as their terms reasonably allow.<sup>2</sup>

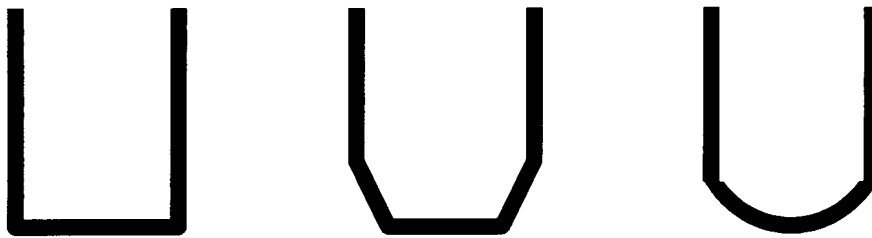
Applicant has argued that Johnson fails to disclose a marking having a U-shaped cross-section. Examiner disagrees based on Johnson's disclosure of a die having raised numerals, wherein the die cooperates with an opposing anvil surface for the purpose of embossing a blank of material positioned between the die and anvil with the respective raised numerals. Applicant is apparently unconvinced that such an impression on the blank of material will resulting in a

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<sup>1</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). *See also* MPEP § 2111.

<sup>2</sup> *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). *See also* MPEP § 2111.01.

marking having a U-shaped cross-section. The letter U has various form or shapes, depending upon the font that the U is referenced. Some U-shapes have a greater radius of curvature than others, and some U-shapes have no radius of curvature (*see examples below*). Therefore, Examiner finds that the raised numerals of Johnson would inherently result in a marking having a “U-shaped” cross-section.



9. Applicant has also brought into question the use of Guidotti et al. as a 35 USC 102(e) reference, as Applicants invention claims priority to German Application 102 37 544.5 filed on October 31, 2002. However, Guidotti et al. claims priority to Italian Application T001A001043 filed on November 2, 2001. Therefore, Guidotti et al. is found to meet the limitations of a 35 USC 102(e) reference.

As explained above, the letter U has various form or shapes, depending upon the font that the U is referenced. Some U-shapes have a greater radius of curvature than others, and some U-shapes have no radius of curvature (*see examples above*).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R. Weeks whose telephone number is (571) 272-4473. The examiner can normally be reached on M-F 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Other helpful telephone numbers are listed for applicant's benefit:

- Allowed Files & Publication (888) 786-0101
- Assignment Branch (800) 972-6382
- Certificates of Correction (703) 305-8309
- Fee Questions (571) 272-6400
- Inventor Assistance Center (800) PTO-9199
- Petitions/special Programs (571) 272-3282
- Information Help line 1-800-786-9199

/Gloria R. Weeks/

Examiner

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October 14, 2007

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal flourish extending to the right.

Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700